

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte STEPHEN L. GALBRAITH, BRIAN SUCHARSKI  
and RAYMOND W. DREA

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Appeal No. 2001-1915  
Application No. 09/362,590

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ON BRIEF

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Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 4, 8-11 and 15-17. Claims 18 and 19 have been allowed, and claims 5-7 and 12-14 have been indicated as containing allowable subject matter.

We REVERSE.

### BACKGROUND

The appellants' invention relates to a mounting bracket for mounting a luggage rack on a motorcycle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Abram	4,030,750	Jun. 21, 1977
Wright	5,984,331	Nov. 16, 1999

Claims 1, 4, 8-11 and 15-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wright in view of Abram.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 10) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 9) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection is under Section 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The objective of the appellants' invention is to conceal from view the fasteners by which a bracket for mounting a luggage rack upon the rear fender of a motorcycle is attached in order to enhance the aesthetic appearance of the motorcycle. As manifested in independent claim 1, the invention is a motorcycle comprising a frame having front and rear wheels and a fender positioned over the rear wheel, a seat, a plurality of fasteners, a mounting bracket extending under the seat and coupled to the fender by the fasteners "wherein all fasteners used to secure said mounting bracket to said rear fender are under

said seat and not visible during normal operation of said motorcycle,” and a luggage rack secured to the mounting bracket.

It is the examiner’s view that all of the subject matter recited in claim 1 is disclosed by Wright, except for the luggage rack, which is shown by Abram. The examiner takes the position that it would have been obvious for one of ordinary skill in the art to mount a luggage rack on the Wright mounting bracket “since this is common to facilitate transport of cargo” (Answer, page 4). While the mounting bracket disclosed by Wright extends under the motorcycle seat, it is quite clear from Figure 1 that at least one of the plurality of fasteners used to attach the mounting bracket to the rear fender is visible during normal operation of the motorcycle. With regard to this, the examiner advances two theories. The first is that “certain fasteners are clearly under the seat” and these fasteners “are considered to comprise ‘all fasteners’ to the same degree as claimed” (Answer, page 3). The second theory is that the elimination of those fasteners that are visible “would have been obvious since it has been held that the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art” (Answer, page 4, citing In re Karlson, 311 F.2d 581, 584, 136 USPQ 184, 186, (CCPA 1963)).

It is our opinion that neither of the examiner’s theories is on firm ground. As to the first, the fact is that Wright has disclosed some mounting bracket fasteners that are

beneath the seat and therefore meet the terms of the claim and at least one fastener that is visible and thus is not in accord with the claims. Nevertheless, the visible one is a mounting bracket fastener, which is not permitted by the claim, and we know of no authority that allows the examiner simply to decide to disregard a portion of the structure of a reference that is relevant to the issue of patentability, which is what was done in this case.

The second theory is based upon the conclusion that the visible fastener really is not necessary to Wright's invention. As disclosed, Wright's mounting bracket is attached at its forward portion by four fasteners and at its rearward portion by at least one. While the reference states that not all of the holes will be used in any particular motorcycle (column 2, line 55), it is our opinion that one of ordinary skill in the art would have recognized that removal of the rear fastener would at the very least be quite detrimental to the proper attachment of the mounting bracket to the fender of the motorcycle, for it would leave the rear portion free to move and/or to twist, especially under the load applied by the weight and movement of a rider sitting in the seat attached to the bracket, a condition that could have serious consequences. Thus, in the absence of evidence to the contrary, the examiner's conclusion that the rear fastener is unnecessary is mere speculation, and for the reasons explained by the appellants on page 4 of the Brief, this situation differs from that presented to the court in In re Karlson. Consideration of the teachings of Abram does not alter our conclusions.

It is our opinion that the combined teachings of Wright and Abram fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection of this independent claim or of claim 4, which depends therefrom.

We reach the same conclusion with regard to independent claims 10 and 16, which contain the same limitation regarding the visibility of the mounting bracket fasteners and, it follows, the claims that depend from them.

#### SUMMARY

The rejection of claims 1, 4, 8-11 and 15-17 as being unpatentable over Wright in view of Abram is not sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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APPEAL NO. 2001-1915 - JUDGE ABRAMS  
APPLICATION NO. 09/362,590

APJ ABRAMS

APJ FRANKFORT

APJ NASE

DECISION: **REVERSED**

Prepared By:

**DRAFT TYPED:** 25 Jun 02

**FINAL TYPED:**